



Docket No.: 0905-0266P
(PATENT)

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Patent Application of:
Sugio MAKISHIMA et al.

Application No.: 09/922,869

Confirmation No.: 008515

Filed: August 7, 2001

Art Unit: 2624

For: PRINT SYSTEM AND METHOD OF
CONTROLLING OPERATION OF SAME

Examiner: K. Y. Poon

APPEAL BRIEF

MS Appeal Brief - Patents
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Sir:

As required under § 41.37(a), this brief is filed in furtherance of the Notice of Appeal filed April 20, 2006. A Request for Pre-Appeal Brief Review was filed in this case with the Notice of Appeal, and a Notice of Panel Decision from Pre-Appeal Brief Review was mailed June 6, 2006. This brief is being filed within two months of the date of the Notice of Panel Decision with a petition for a one-month extension of time.

The fees required under § 41.20(b)(2) are dealt with in the accompanying TRANSMITTAL OF APPEAL BRIEF.

This brief contains items under the following headings as required by 37 C.F.R. § 41.37 and M.P.E.P. § 1206:

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| II | Related Appeals and Interferences |
| III. | Status of Claims |
| IV. | Status of Amendments |

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I. REAL PARTY IN INTEREST

The real party in interest for this appeal is:

Fuji Photo Film Co., Ltd.

II. RELATED APPEALS, INTERFERENCES, AND JUDICIAL PROCEEDINGS

There are no other appeals, interferences, or judicial proceedings which will directly affect or be directly affected by or have a bearing on the Board's decision in this appeal.

III. STATUS OF CLAIMS

A. Total Number of Claims in Application

There are 13 claims pending in application.

B. Current Status of Claims

1. Claims canceled: none
2. Claims withdrawn from consideration but not canceled: 5, 6, 8, 9
3. Claims pending: 1-13
4. Claims allowed: none
5. Claims rejected: 1-3, 7, 10-13
6. Claims objected to: 4

C. Claims On Appeal

The claims on appeal are claims 1-3 and 10-13

IV. STATUS OF AMENDMENTS

Applicant filed an Amendment After Final Rejection on March 17, 2006. The examiner responded to the Amendment After Final Rejection in an Advisory Action mailed March 30, 2006. In the Advisory Action, the examiner indicated that Applicants' proposed cancellation of claim 7 and amendment to rewrite objected-to claim 4 to include the limitations of its base claims would not be entered because these amendments raised new issues.

Accordingly, the claims enclosed herein as Appendix A do include claim 7 even though Applicant wishes to cancel this claim and do not incorporate the amendments to claim 4 that, according to the final Office Action, would have made claim 4 allowable. However, the claims in Appendix A do incorporate the amendments indicated in the paper filed by Applicant on July 12, 2005.

V. SUMMARY OF CLAIMED SUBJECT MATTER

Claim 1

Claim 1 requires a print system (1 in Figure 1; page 10, lines 10-13) comprising a housing (illustrated in Figure 1), an input unit on the housing for inputting a contact destination to be contacted at end of printing (2 in Figure 1; Figure 3; page 12 lines 7-11 and 101 in Figure 8), a printer (19 in Figure 2) in the housing for printing an image on a visible recording medium (35 in Figure 4), a first determination unit for determining whether printing by said printer has ended (page 2, lines 7-20; 51 in Figure 6), and a transmitting unit (page 2, lines 7-20; 101 in Figure 8; 12 in Figure 2), which is responsive to a determination by said determination unit that printing has ended, for transmitting data indicating that printing has ended (50, 51, 52 in Figure 6) to a data processing unit outside the housing (90 in Figure 8; page 17, line 27 through page 18, line 8) and specified by the contact destination input by said input unit, via a communication channel (page 3, lines 6-17).

Claim 2

Claim 2 requires the print system of claim 1 wherein the data processing unit (90 in Figure 8) is capable of short-distance communication with said print system (100 in Figure 8; page 3, line 26 through page 4, line 9), the input unit receives identification data, which identifies said data processing unit, as the contact destination transmitted from said data processing unit by short-distance communication (page 24, line 24 through page 25, line 3), and the transmitting unit transmits the data indicating that printing has ended (page 17, line 27 through page 18, line 8) to said data processing unit (90 in Figure 8), which is identified by the identification data, by short-distance communication.

Claim 3

Claim 3 requires the print system of claim 2 that further includes an image data receiving unit (101 in Figure 8) for receiving image data transmitted from said data processing unit (90 in Figure 8) by short-distance communication, wherein the printer records an image (Figure 4) represented by the image data, which has been received by said image-data receiving unit, on a

visible recording medium (35 in Figure 4; page 14, lines 4-8).

Claim 10

Claim 10 requires the system of claim 1 and, in addition, a media inserting unit for inserting a medium storing image data (5,6, 7 in Figure 1; page 12, lines 19-25), where the printer prints the image represented by the image data recorded on the inserted medium on the visible recording medium (Figure 4).

Claim 11

Claim 11 requires, in addition to the system of claim 1, a display unit (31 and 32 in Figure 3) for displaying the contact destination received by said input unit.

Claim 12

Claim 12 requires a print system (1 in Figure 1) that includes a keypad (Figure 3) for inputting a contact destination to be contacted at the end of a printing (page 13, line 7 through page 14, line 1), a printer (19 in Figure 2) for printing images on visible recording media (35 in Figure 4), a determination unit for determining whether the printing by said printer has ended (page 2, lines 7-20), and a transmitting unit (12 in Figure 2; 101 in Figure 8) responsive to a determination by said determination unit (page 17, line 27 through page 18, line 8) that the printing has ended for transmitting to a data processing unit via a communication channel data indicating that the printing has ended (page 2, lines 7-20).

Claim 13

Claim 13 requires a method of controlling operation of a print system that involves inputting by a keypad a contact destination to be contacted at the end of a printing of an image on a visible recording medium (49 in Figure 6), printing an image on a visible recording medium (50 in Figure 6), determining whether the printing has ended (51 in Figure 6), and in response to a determination that the printing has ended, transmitting, via a communication channel, data indicating that the printing has ended to a data processing unit specified by the contact

destination (52 in Figure 6; page 3, lines 6-17).

VI. GROUNDS OF REJECTION TO BE REVIEWED ON APPEAL

Whether claims 1-3, 10 and 11 are unpatentable under 35 U.S.C. 103(a) over Tamura, U.S. 6,771,896, in view of Parulski, U.S. 6,573,927 and Attenberg, U.S. 5,913,019.

Whether claims 12 and 13 are unpatentable under 35 U.S.C. 103(a) over Tamura, U.S. 6,771,896 in view of Wu, U.S. 6,292,307.

VII. ARGUMENT

Claim 1

Claim 1 is rejected under 35 U.S.C. 103(a) as being unpatentable over Tamura in view of Parulski and Attenberg. Claim 1 requires a print system that includes, *inter alia*, a housing, an input unit on the housing for inputting a contact destination to be contacted at end of printing and a printer in the housing. Tamura teaches a system which includes an order counter 210 on which a camera can be placed in alignment with a receiver 211 and a printing apparatus 220 electrically connected to the receiver. Tamura also indicates that the printer and the counter can be separate or “united solidly” (column 15, line 28). However, Tamura does not show an input unit on a housing, such as the housing of printer 220, and a printer in the housing as required by claim 1.

The examiner appears to argue that Parulski and Attenberg taken together with Tamura suggest placing Tamura’s printing apparatus 220 and counter 210 into a housing. It is respectfully submitted that a proper motivation for making this modification to Tamura has not been provided and that therefore a *prima facie* case of obviousness has not presented. However, even if a motivation for modifying Tamura in this manner were provided, the result would not be the invention required by claim 1. Each of these issues is addressed below.

Claim 1 requires an input unit on a housing and a printer in the housing. Placing Tamura’s printing apparatus 220 and counter 210 “in a housing” as stated in the final Office Action would not result in the invention required by claim 1. That is, placing both elements in a

housing would not result in an input unit on a housing and a printer in the housing as required by claim 1. Therefore, even if a motivation for modifying Tamura were provided, the result would not be the invention of claim 1.

In addition, a proper motivation for modifying Tamura has not been provided. The examiner appears to rely on Official Notice to establish that “things that are solidly united probably are under a same housing.” Applicant respectfully submits that this statement is not capable of “instant and unquestionable demonstration” as would be required in order for a fact to be officially noticed. MPEP 2144.03. Furthermore, no technical line of reasoning has been provided in support of this reliance on Official Notice as required by MPEP 2144.03. In addition, Applicant has challenged this reliance on Official Notice in response to the final Office Action, but no reference has been identified to support this statement. Applicant therefore maintains that a proper basis for taking Official Notice of the above statement has not been made of record, and to the extent that this statement is being relied upon by the examiner to support the rejection of claim 1, the rejection is respectfully traversed as not being supported by the written record.

The examiner also relies on Parulski to show an input device and a printer in a housing. Parulski discloses a method of ordering prints. At column 3, line 67, Parulski indicates that “the user can place the card 36 in a slot 50 of a ‘walk-up kiosk’ 16 along with a credit card.” No other description of the kiosk is provided, although Figure 1B includes a schematic representation of a kiosk. This figure shows a printer located at “downstream service provider 14” and shows that kiosk 16 includes a memory and “print engine,” but does not show a printer in a kiosk as stated by the examiner. Even if Parulski’s kiosk 16 includes a printer, nothing in the record shows or suggests that the kiosk includes an input unit on a housing and a printer in the housing as required by claim 1. Therefore, even if a motivation for combining Tamura and Parulski were provided, the result would not be the invention required by claim 1.

Attenberg is also cited to show various devices in a kiosk. However, Attenberg is a walk-up photo device that includes a camera for taking a user’s picture and printing out stickers bearing the user’s image. Attenberg does not appear to suggest any modification to Tamura that would result in the invention of claim 1. At most, Attenberg might suggest placing a printer in a

kiosk, but it in no manner suggests placing an input device on a housing with a printer in the housing as required by claim 1.

The examiner may be arguing that it would be possible to modify Tamura as suggested in the Office Action. However, it is respectfully submitted that the fact that it might be possible to modify a reference does not constitute a basis for an obviousness rejection unless a motivation for making a combination or modification can be shown. MPEP 2143.01.

The examiner offers several statement that may be intended to show a motivation to combine or modify references. It is respectfully submitted, however, that only “goals” have been identified without providing any motivation would lead a person to that goal. For example, reducing the cost of an existing product is generally considered desirable. This does not mean, however, that every method of reducing cost is obvious. In other words, the fact that a goal is desirable does not indicate that a particular means of attaining that goal is obvious. In the present case, the “motivations” for combining references are submitted to be no more than statement of goals. It is not even clear that these “goals” are recognized in the prior art – some seem to be taken from the present disclosure. Thus, the Office Action states a combination would be obvious “to reduce space such that rent would be reduced for commercial vendors.” There is no basis for this statement in the prior art, and even if true, it does not mean that every modification to a reference that saves space is obvious. It is further stated that “the system would be well protected.” This might be desirable, but the art of record in no manner suggests inadequate protection is a problem that needs to be addressed. Finally, the goal of “let users known it a system as a whole for convenient [sic]” is asserted. This “goal” may be understood from the present disclosure, but it does not come from the references of record, and no explanation has been provided to show why this statement would be known to those skilled in the art.

The Advisory Action also discusses “benefits” that would be obtained by combining the references of record. However, it is respectfully submitted that identifying alleged benefits of a combination in hindsight does not show why one skilled in the art would have been motivated to combine references without the benefit of the present disclosure.

For the above reasons, it is respectfully submitted that a motivation for combining

Tamura, Parulski and Attenberg has not been provided, that a *prima facie* case of obviousness has not been presented, and that claim 1 is allowable over the references of record.

Claim 2

In addition to the limitations of claim 1, claim 2 requires that the input unit receive identification data which identifies the data processing unit as the contact destination transmitted from the data processing unit. Claim 2 also requires that the transmitting unit transmit the data indicating that printing has ended to the data processing unit identified by the identification data. Tamura discusses, at column 5, line 1, how information on “the state of order receiving” is transmitted to the camera. However, information regarding when printing has ended is not transmitted by Tamura’s system. Instead, Tamura may set a timer on the camera to predict when printing has ended, and the camera can be removed from the counter. No data indicating that printing has ended is transmitted by Tamura’s system. Parulski and Attenberg do not address this shortcoming of Tamura, and claim 2 is submitted to further distinguish over the references of record for this reason.

Claim 3 depends from claim 2 and is submitted to be allowable for at least the same reasons as claim 2.

Claim 10 depends from claim 1 and is submitted to be allowable for at least the same reasons as claim 1.

Claim 11

Claim 11 depends from claim 1 and further requires a display unit for displaying contact information received by the input unit. This is not shown in Tamura or Parulski. The examiner indicates that Figure 4 of Parulski shows a display for displaying contact information, but Figure 4 of Parulski shows a “diagram of the utilization of a utilization file” (column 2, line 37). The examiner also cites to two sections of Parulski’s claims where displaying an image to be printed is discussed. Neither these portions of Parulski nor the remainder of Parulski show a display for displaying contact information as required by claim 11, and claim 11 is submitted to be allowable over the references of record for at least this reason.

Claim 12

Claim 12 is rejected as being unpatentable over Tamura in view of Wu. Tamura is alleged to show all elements required by claim 12 except for a keypad for inputting a contact destination to be contacted at the end of printing. Wu discloses a digital camera having a keypad 8. However, it is respectfully submitted that a motivation for combining Tamura and Wu has not been provided, that a *prima facie* case of obviousness has not been presented, and that claim 12 is allowable over Tamura and Wu.

The examiner indicates that keypads for inputting information are well known in the art. However, as provided in MPEP 2143.01, "A statement that modifications of the prior art to meet the claimed invention would have been 'well within the ordinary skill of the art at the time the claimed invention was made' because the references relied upon teach that all aspects of the claimed invention were individually known in the art is not sufficient to establish a *prima facie* case of obviousness without some objective reason to combine the teachings of the references." *Ex parte Levengood*, 28 U.S.P.Q. 2d 1300 (BPAI 1993). The motivation provided by the examiner is that such a modification "would have allowed digital camera with keypad to make use of Tamura's invention to increase the market share to increase profit." Nothing in the record suggests that cameras with keypads will allow for the increase of market share or profit, and a proper motivation for modifying Tamura in view of Wu has not been provided. It is therefore respectfully submitted that the combination of Tamura and Wu is based only and impermissibly on hindsight and the teachings of the present application. Because a motivation for modifying Tamura in view of Wu has not been provided, it is respectfully submitted that claim 12 is allowable over the art of record.

Claim 13 is rejected under 35 U.S.C. 103(a) as being unpatentable over Tamura in view of Wu. This rejection is respectfully traversed for the reasons provided above in connection with claim 12.

VIII. CLAIMS

A copy of the claims involved in the present appeal is attached hereto as Appendix A. As indicated above, the claims in Appendix A do include the amendments filed by Applicant on

July 12, 2005, and do not include the amendment(s) filed on March 17, 2006.

IX. EVIDENCE

No evidence pursuant to §§ 1.130, 1.131, or 1.132 or entered by or relied upon by the examiner is being submitted.

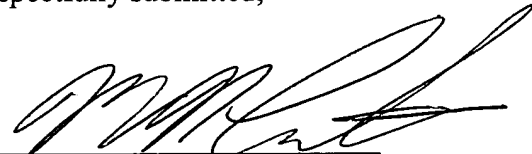
X. RELATED PROCEEDINGS

No related proceedings are referenced in II. above, or copies of decisions in related proceedings are not provided, hence no Appendix is included.

Dated: August 7, 2006

Respectfully submitted,

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APPENDIX A

Claims Involved in the Appeal of Application Serial No. 09/922,869

1. A print system comprising:
 - a housing;
 - an input unit on the housing for inputting a contact destination to be contacted at end of printing;
 - a printer in the housing for printing an image on a visible recording medium;
 - a first determination unit for determining whether printing by said printer has ended; and
 - a transmitting unit, which is responsive to a determination by said determination unit that printing has ended, for transmitting data indicating that printing has ended to a data processing unit outside the housing and specified by the contact destination input by said input unit, via a communication channel.

2. The system according to claim 1, wherein said data processing unit is capable of short-distance communication with said print system;
 - said input unit receives identification data, which identifies said data processing unit, as the contact destination transmitted from said data processing unit by short-distance communication; and
 - the transmitting unit transmits the data indicating that printing has ended to said data processing unit, which is identified by the identification data, by short-distance communication.

3. The system according to claim 2, further comprising an image data receiving unit for receiving image data transmitted from said data processing unit by short-distance communication;
 - wherein said printer records an image represented by the image data, which has been received by said image-data receiving unit, on a visible recording medium.

10. The system according to claim 1, further comprising:

a media inserting unit for inserting a medium storing image data;
wherein said printer prints the image represented by the image data recorded on the inserted medium on the visible recording medium.

11. The system according to claim 1, further comprising:

a display unit for displaying the contact destination received by said input unit.

12. A print system comprising:

a keypad for inputting a contact destination to be contacted at the end of a printing;

a printer for printing images on visible recording media;

a determination unit for determining whether the printing by said printer has ended; and

a transmitting unit responsive to a determination by said determination unit that the printing has ended for transmitting to a data processing unit via a communication channel data indicating that the printing has ended.

13. A method of controlling operation of a print system comprising the steps of:

inputting by a keypad a contact destination to be contacted at the end of a printing of an image on a visible recording medium;

printing an image on a visible recording medium;

determining whether the printing has ended; and

in response to a determination that the printing has ended, transmitting, via a communication channel, data indicating that the printing has ended to a data processing unit specified by the contact destination.

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APPENDIX B

No evidence is being submitted.

APPENDIX C

There are no related proceedings.